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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Prostats LLC

Serial No. 74/090,380

Philip P. Mann of Ryan, Maki, Mann & Hohenfeldt, S.C. for
Prostats LLC.

Peter Cataldo, Trademark Examining Attorney, Law Office 103
(Michael Szoke, Managing Attorney).

Before Cissel, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 19, 1996, applicant filed the above-
referenced application to register the mark shown below

on the Principal Register for a "computer software program
which compiles and organizes statistical information for
the purpose of measuring the performance of golfers," in
Class 9. The basis for filing the application was

applicant's assertion that it possessed the bona fide intention to use the mark in connection with such goods in commerce.

The Examining Attorney refused registration under Section 2(e)(1) of the Act on the ground that the mark sought to be registered is merely descriptive of the goods specified in the application. In support of the refusal, he made of record excerpts retrieved from the Nexis® automated database of publications which show that the term "tour pro" is used in reference to golfers who compete in a professional tour. Typical examples include the following: "POWER GOLF: Tour pro John Daly goes well beyond parallel at the top of his swing."; "... yet another tour pro who dabbles in golf course architecture..."; "...Although several PGA Tour pros--among them Corey Pavin and Steve Lowery--call Bay Hill home..."; "...whether Costner's golf swing would have the authentic look of a tour pro's can be put to rest."; "The playing tour pro out of King Valley Golf Club will go into today's third round with a one-stroke lead..."; and "His advice for any tour pro thinking of changing his game plan midway through a round straight out of the Houston School of homespun Philosophy..."

Applicant responded to the refusal with argument that the mark is not merely descriptive because "A consumer

seeing the mark 'TourProStats' on typical computer program packaging would not automatically know what precisely the packaging contained or, more importantly, what exactly the program did." Further, applicant contended that "there is nothing in the description of goods that indicates that the computer program must be used to compile statistical information relating to professional[,] as opposed to amateur golfers."

The Examining Attorney was not persuaded by applicant to withdraw the refusal, which was made final in the second Office Action. Submitted with that action were copies from additional articles retrieved from the Nexis® database. These excerpts show that the term "stats" is used as a shortened version of the word "statistics." Examples include the following: "Two laptop computers containing backup disks, on which all of the cumulative stats for both teams are located..."; "...he rarely watches games, but receives statistics from a stats service and feeds them into a computer program he has designed..."; "...quick statistics weren't available...the computerized stats system is not operative..."; and "Some mice got into the computerized stats system. It is not operative this week, believe it or not, due to mouse damage."

The Examining Attorney concluded that the record shows that a tour pro is a golfer and that computer programs keep track of stats, and he held that the mark is merely descriptive because it provides information about the purpose or function of the goods. His position is that a prospective purchaser, presented with the mark "TourProStats" on applicant's computer program, which compiles and organizes statistical information about golfers, would understand that the purpose or function of the program is to manage tour pro statistical information.

Applicant submitted more argument with a request for reconsideration, but the Examining Attorney maintained the refusal to register, so applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board. Submitted with the Examining Attorney's brief was a copy of a dictionary definition, of which the Board could take judicial notice anyway, of the word "stats" as a synonym for "statistics."

The sole issue in this appeal is whether the mark "TourProStats" is merely descriptive of computer programs for compiling and organizing statistics about the performance of golfers.

The test for determining whether a mark is merely descriptive within the proscription of Section 2(e)(1) of the Act is well settled. A mark is merely descriptive of the goods with which it is used if it immediately and forthwith conveys information about the characteristics, purpose, use or function of the goods. In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ591 (TTAB 1979). As noted by the Examining Attorney, this determination must be made by considering the mark in relation to the specified goods, and not in the abstract. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

When these principles are applied to the facts of the instant case, we find that the mark is unregistrable under Section 2(e)(1) because, when it is considered in connection with the computer programs specified in the application, it conveys their use, purpose or function, i.e., that they relate to statistics for golfers who are tour pros. As put by the Examining Attorney in his brief, at p. 4, "Stated succinctly, that applicant's goods compile and organize tour pro stats."

Applicant argues that because the record does not contain examples of "TourProStats" or "tour pro stats" used as the common descriptive name of anything, much less as

the name of computer software, the term cannot be considered to be descriptive, and that unless the composite mark is "impermissibly broken up into its constituent parts" (reply brief, p. 1.), the descriptive meaning cannot be discerned. Applicant takes the position that because its goods are not tour pro statistics, but rather are computer programs, some degree of thought and imagination is needed to draw the link between applicant's program and such statistics, which makes the mark only suggestive, rather than descriptive. Applicant even argues that the mark is not descriptive of the goods because the use of its product is not limited to touring professional golfers. None of these arguments is persuasive.

In order for the mark to be unregistrable as merely descriptive, it does not have to be the generic name for anything. It is sufficient if it conveys information about the characteristics of the goods with which it is used. In re MetPath, supra. That applicant may be the first, or even the only one, to use a descriptive term does not make the term any less descriptive. In re Pennzoil Products, Inc., 20 USPQ2d 1753 (TTAB 1991). It is not impermissible to consider the ordinary meanings of the individual words combined in a term in order to determine the connotation of the combined term. In fact, it would be improper not to

consider the mark in its entirety. No mental gymnastics are required to understand from the mark that the software relates to tour pro statistics. No reasonable person would think that the goods are the stats themselves. That these programs may be used to compile and organize stats for amateur golfers as well as touring professionals does not make the mark any less descriptive of such goods used in connection with tour pros. To run afoul of Section 2(e)(1), the mark does not need to describe all of the potential uses or functions of the goods. One is sufficient. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982).

DECISION: The refusal to register is affirmed.

R. F. Cissel

C. E. Walters

D. E. Bucher
Administrative Trademark Judges
Trademark Trial and Appeal Board

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